

## **REMARKS**

### **STATUS OF THE CLAIMS**

Claims 1-3 and 5-58 were pending. Pursuant to a restriction requirement, claims 43, 44 and 53-58 have been withdrawn from consideration and have been canceled, without prejudice or disclaimer, by amendment herein.

Claims 19 and 20 have been amended to include all the limitations of previously pending claim 1. Thus, no new matter has been added as a result of these amendments. The amendments are made solely to expedite prosecution of claims deemed allowable in the Advisory Action. Applicants reserve the right to file one or more continuing applications to the subject matter of the canceled claims.

Thus, allowable claims 19-22, 24-42, 45, 46 and 59 are pending as shown above.

### **REJECTIONS WITHDRAWN**

Applicants note with appreciation that the rejections under 35 U.S.C. § 112, second paragraph and 35 U.S.C. § 102(b) were withdrawn. (Advisory Action, paragraph 3).

### **35 U.S.C. § 103**

For the reasons of record, Applicants reiterate their traversal of the rejection of canceled claims 4-12, 14-18, 50-52 and 58 under 35 U.S.C. § 103 as allegedly obvious over Knudtson in combination with one or more secondary references. (Advisory Action, throughout). In particular, the fact that the claimed transposons function in gram-positive bacteria is not an "intended use" but, rather, a functional limitation. Thus, even assuming, for the sake of argument only as the Office has not shown it to be the case, that Knudtson's transposon cassettes would function in gram-positive bacteria, that which is allegedly inherent is not necessarily obvious:

The inherency of an advantage and its obviousness are entirely different questions. That which may be inherent is not necessarily known. Obviousness cannot be predicated on what is unknown. *In re Shetty, supra* quoting *In re Sporman*, 150 USPQ 449 (CCPA 1966).

In the pending case, it was certainly not known prior to the filing of the instant application that transposon cassettes as claimed would function in gram-positive bacteria.

In any event, the cancellation of these claims render the rejection moot. Applicants reserve the right to file a continuation application directed to the subject matter of these claims.

**CONCLUSION**

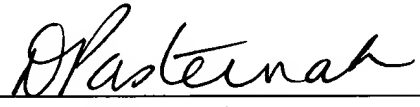
Applicants believe that the claimed subject matter is now in condition for allowance and early notification to that effect is respectfully requested. If any issues remain to be addressed, the Examiner is encouraged to telephone the undersigned.

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Respectfully submitted,

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